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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,637	06/04/2001	Jeffrey Ross	960296.98164	5237

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EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,637

Applicant(s)

ROSS, JEFFREY

Examiner

Misook Yu

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims (1-15) in part, drawn to cancer diagnosis by detecting CRD-BP expression levels using immunological method, classified in class 435, subclass 6.
- II. Claims 1 in part, 2 in part, 7 in part, (8-15) in part, drawn to cancer diagnosis by detecting CRD-BP expression levels using in situ hybridization method, classified in class 435, subclass 7.1.
- III. Claim 15, drawn to method of determining the stage of cancer by determining CRD-BP expression levels, classified in class 435, subclass 6, and subclass 7.1.
- IV. Claims 16, drawn to method of detecting autoimmune bodies to CRD-BP, class 436, subclass 506.
- V. Claim 17, drawn to method of determining the presence or absence of CRD-BP in patient's serum, classified in class 435, subclass 7.1.
- VI. Claim 18 in part, and 19, drawn to method of cancer treatment using a competitor RNA to CRD-BP, classified in class 514, subclass 44.
- VII. Claims 18 in part, 20 drawn to method of cancer treatment using unidentified inhibitor, unclassifiable due to unknown nature the treatment.

The inventions are distinct, each from the other because of the following reasons:

Inventions groups I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions groups I-VII are different methods using different assay systems requiring materially different reagents and method steps for achieving different objectives.

These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. The search required

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for each of the above inventions is not coextensive with regard to the literature and the sequence searches. Further, a reference which would anticipate the invention of any one group would not necessarily anticipate or make obvious the any of the other groups. For these reasons, restriction for examination purposes is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention.

Group I contains claims generic to a plurality of disclosed patentably distinct species of two classes of genuses. First, the different cancers listed in claim 8 are patentably distinct because they have different etiology and respond differently to a given treatment. Claims 9-14 will be examined as they are drawn to an elected species. Second, the different immunological testings disclosed in claims 3-6 are patentably distinct because require different reagents. If group I is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of the two genuses, even though this requirement is traversed.

Group II contains claims generic to a plurality of disclosed patentably distinct species. The different cancers listed in claim 8 are patentably distinct because they have different etiology and respond differently to a given treatment. Claims 9-14 will be examined as they are drawn to an elected species. If group II is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).


Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu, Ph.D.
August 28, 2002


MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800
1602